

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEIJI SUZUKI and HIROYUKI SOGA

Appeal No. 2004-2012
Application No. 09/183,087

ON BRIEF

Before ABRAMS, McQUADE, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a diaper. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Lawson	4,695,278	Sep. 22, 1987
Robertson	5,026,364	Jun. 25, 1991
Japanese Kokai ¹ (Daio)	02174845	Jul. 6, 1990
UK Patent Application (Uni-Charm)	2 251 172 A	Jul. 1, 1992

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Uni-Charm in view of Lawson, Daio and Robertson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 42) for the examiner's reasoning in support of the rejection, and to the Brief (Paper No. 41) and Reply Brief (Paper No. 43) for the appellants' arguments thereagainst.

OPINION

¹Our understanding of this foreign language document was obtained from a PTO translation, a copy of which is enclosed.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants' invention is directed to a disposable diaper for absorbing and containing excretion. In furtherance of this objective, the diaper comprises inner and outer pairs of side barrier cuffs extending along the transversely opposite side edges of a top sheet and a pair of end barrier flaps extending along its longitudinal opposite ends. The outer ones of the side barrier cuffs extend to the longitudinally opposite ends of the diaper and form inwardly opening pockets, while the inner ones of the side barrier cuffs extend parallel to the outer side barrier cuffs to locations spaced inwardly of the longitudinally opposite ends of the diaper and also form inwardly opening pockets. The end barrier flaps cover the opposite ends of the outer side barrier flaps.

Independent claim 1 and dependent claims 2-7 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of the teachings of Uni-Charm taken in view of those of Lawson, Daio and Robertson. In arriving at this conclusion, the examiner finds all of the subject matter recited in claim 1 to be disclosed or taught by Uni-Charm, except for the ends of the second (inner) side barrier cuffs extending to locations spaced inwardly of the opposite ends of the diaper and the end barrier flaps. However, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art

to modify the Uni-Charm diaper by shortening the length of the inner cuffs in view of the teachings of Lawson and Robertson “in view of the recognition” in the prior art that inner cuffs “are inevitably longer” than outer cuffs, and to add end barrier flaps in view of the teachings of Robertson and Daio “in view of the recognition” in the prior art that end flaps “enable the article to more effectively contain body exudates” (Answer, page 5).

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness under 35 U.S.C. §103, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (BPAI 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Applying this guidance to the situation at hand leads us to agree with the appellants that this rejection should not be sustained. Our reasoning follows.

Claim 1 requires that there be a pair of first side barrier cuffs adjacent the side edges of the diaper and extending longitudinally “to said longitudinally opposite ends of said diaper” and a pair of second side barrier cuffs extending parallel to the first barrier cuffs “to locations spaced apart inwardly of said longitudinally opposite ends of said diaper.” Uni-Charm discloses first (15) and second (16) side barrier cuffs but, as can be seen in Figure 2, both are the same length and extend to the longitudinally opposite ends of the diaper, and therefore Uni-Charm fails to disclose or teach that the inner cuff does not extend to the ends of the diaper. Daio is the only other reference that discloses two sets of parallel longitudinally extending cuffs, but as was the case in Uni-Charm, the first cuffs (20) and the second cuffs (10) are of the same length and both extend to the ends of the diaper (see Figure 2).

Recognizing this deficiency in the teachings of the applied references, the examiner advances the following theory: (1) It was known in the art to provide cuffs that extend the entire length of a diaper and for the length of a conventional diaper to be 450 mm, as evidenced by Lawson and Robertson, and thus one of ordinary skill in the art would have appreciated that it would have been obvious to make the Uni-Charm diaper of such a length. (2) It then follows that the Uni-Charm first (outer) cuff 15, which is shown in Figure 2 as extending the full length of the diaper, also would have a length of 450mm. (3) The statement on page 11 of Uni-Charm that the longitudinal dimension of the second (inner) cuff 16 “may be less than 100mm” teaches that the second cuff is

of lesser length than the first cuff and thus terminates at a point spaced inwardly of the ends of the diaper, thus meeting this limitation of the claim. However, as the appellants have pointed out, the examiner's interpretation of the 100mm teaching is incorrect, for the entirety of the passage to which the examiner refers states that this dimension is "measured in accordance with the Japanese-Industrial-Standard-P8143," which standard is directed to measuring the stiffness of paper in terms of the units of length which allow a suspended length of paper to be rotated or twisted 90 degrees about a line axially passing through the ends, and this has nothing to do with the length of the cuffs shown in Uni-Charm. Evidence in support of this interpretation was provided by the appellants by reference to U.S. Patent No. 6,475,569, at column 2, lines 29-36. The examiner has not disputed this interpretation of the passage in issue, and therefore the appellants' conclusion stands uncontroverted.

This being the case, the evidence adduced by the examiner fails to demonstrate that it would have been obvious to one of ordinary skill in the art to modify the Uni-Charm diaper such that the second (inner) cuffs extend to locations "spaced apart inwardly of said longitudinally opposite ends of said diaper," as is required by independent claim 1. The applied references therefore fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and the standing rejection of claims 1-7 cannot be sustained.

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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